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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,416	07/29/2003	Steven P. McGahn	112300-1666	5965
29159	7590	01/19/2006	EXAMINER	
BELL, BOYD & LLOYD LLC			SHAH, MILAP	
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3714

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/629,416	MCGAHN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/29/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***DETAILED ACTION***

This action is in response to amendment received on January 21, 2005. The Examiner acknowledges that claims 1, 18, 32, 44, 57, 58 & 65 have been amended and that no new claims have been added. Thus, claims 1-74 are currently pending. The Examiner also acknowledges the submission of a Terminal Disclaimer.

***Information Disclosure Statement***

In the amendment filed on January 21, 2005, the Applicant has stated that the Examiner has not indicated the he has considered each of the references on page two of the information disclosure statement considered on September 23, 2004. The Examiner has included, with this action, a new copy of that particular PTO-1449 with each item marked as considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46, 49-51, & 54-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, U.S. Patent 5,823,874 (Oct. 20, 1998) (hereinafter "*Adams*") in view of Groetchen, U.S. Patent 1,978,395 (Apr. 23, 1934) (hereinafter "*Groetchen*").

*Adams* discloses a gaming device incorporating primary and secondary game displays within a single housing. *See fig. 1*. The primary embodiment employs a reel-type slot game as a primary display and a wheel-type game as a secondary display. *See fig. 1; col. 6:16-33*. However, *Adams* suggests the displays may be replaced with other standard gaming units that preferably include mechanical displays to reveal outcomes because they provide patrons a heightened level of anticipation and excitement. *See col. 3:53-60, col. 6:16-33*. Furthermore, *Adams* suggests the games should provide players with clear visual and audible indications to be readily discernable. *See id.* Still furthermore, the reference suggests that the bonus may alternatively employ games requiring elements of player skill. *See col. 6:40-47*.

In specific regards to the Applicants' claims, *Adams* teaches the following features:

- a. Cabinet with primary and secondary display supported by the cabinet. *See fig. 1*. A primary game is adapted to the primary display and a secondary game is adapted to the secondary display.
- b. A display mounted to the cabinet, a plurality of symbols displayed on a portion of the display and a processor operable to select symbols and control the display to display the selected symbols. *See col. 5:30-49*. The player activates the selection of a symbol which is incorporated in the award (i.e. a value enticement award).
- c. A directional indicator displayed by the first display which directs the player to the second display and processor which causes the directional indicator to direct the player to the second display. *See col. 2:30-48, 4:46-59. (Claims 17-19, 44, 45, 61, & 65)*

However, *Adams* lacks slidable members (i.e. a first and/or second movable member, wherein each movable member has its own actuator) selectively masking a portion of the secondary display wherein selected symbols on the secondary display are revealed by actuating the movable member(s) and a processor operable to cause the movable member(s) to reveal a portion of the video display.

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Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

*Groetchen* discloses a slot machine device in which slidable member (i.e. shutters) selectively mask a display wherein the device selects symbol from a plurality of symbols; displays symbols on the display; and reveals the symbols by moving the movable member. *See fig. 1-3; pp. 1:39-54; 1:63-6, 3:13-58*. The reference suggests masking the outcomes with movable shutters allows various games with the device. *See p. 3:44-50*. Generally, *Groetchen* describes a mechanical game device allowing the successive display of game outcomes using movable members.

In view of *Groetchen*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Adams*, wherein a secondary display provides bonus payout, to add a secondary display wherein movable members selectively masks the secondary display, the device selects a symbol from a plurality of symbols; displays the symbol on the secondary display; and actuates the movable member to move to reveal the symbol by actuating the movable member. As suggested by *Adams*, the modification would provide a standard gaming including moving objects that reveal outcomes with clear visual and audible indications and thereby enhance the device by heightening players' level of anticipation and excitement. *See col. 3:53-60*. Furthermore, as suggested by *Groetchen*, the modification would provide an enhanced secondary game display supporting a variety of games. *See p. 3:44-50*.

In further regards to claims 2, 19 and 32: *Adams* additionally teaches a processor for electromechanically controlling a secondary display comprised of a mechanical indicator in which the processor controls the operation of the secondary display. *See 3:60-4:6*. Thus, it would have been obvious to an artisan at the time of the invention to modify the gaming device described by the combination of *Adams* and *Groetchen*, to add the feature of a processor operable to cause the movable member to reveal a portion of the video display to control the movable members. As taught by *Adams*,

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the modification would enhance the device by allowing it to be controlled by a random number generator while maintaining the mechanical appearance of the game. *See col. 3:61-4:6.*

In regards to claims 3, 22, 29, 34 & 50: *Groetchen* teaches a triggering event wherein a processor causes the actuator to move the movable member to reveal the secondary display upon occurrence of the triggering event. *See p. 3:41-50.*

In regards to claims 4-6, 44 and 51: *Groetchen* additionally teaches a plurality of slidable members that mask first and second portions of the second display wherein a motor are connected to each member and a processor causes the motors to slide the members to reveal masked symbols such as award indicia. *See fig. 1-5; p. 3:41-50.*

In regards to claims 7, 20, 46, 59, 65 and 66: *Adams* teaches symbols that include award indicia. *See fig. 1.*

In regards to claims 8, 24, 43, 54, 60, and 67: The game system described by the combination of *Adams* and *Groetchen* does not disclose a speaker by which the processor generates a sound effect when the movable members reveal a secondary display. Regardless, it is notoriously well known in the art for gaming devices to incorporate processors that generate a sound effects through speakers in association with game events to provide players with audio indications in association with visual displays to enhance the interaction and entertainment of players. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of a speaker by which the processor generates a sound effect when the movable member reveals a secondary display to the gaming device described by the combination of *Adams* and *Groetchen* to enhance the device by improving communicating and entertainment through increased interaction with players.

In regards to claims 9, 23 and 35: *Groetchen* teaches an actuator causing the movable member to reveal the secondary display after a player activated device is activated. *See id.*

In regards to claims 10, 25 and 36: *Adams* teaches a secondary display that is a video display. *See col. 5:30-50*. The reference does not describe television, dot-matrix, cathode-ray tubes, light-emitting diode, liquid crystal, and electro-luminescent displays. Regardless, these display means are equivalents substitutable for the same purpose of displaying visual game information to a player. Thus, it would have been obvious to an artisan at the time of the invention to modify *Adams*, wherein the secondary display is a video display, to substitute television, dot-matrix, cathode-ray tubes, light-emitting diode, liquid crystal, and electro-luminescent displays to display visual game information to a player.

In regards to claims 11-16, 26, 37-42, 55, 56, 62-64 and 68-71: *Adams* teaches a secondary display that includes a mechanical reel, movable roller or wheel displaying award indicia. *See col. 6:17-33*.

In regards to claims 21, 33 and 49 *Groetchen* teaches movable members made of non-transparent material. *See fig. 1-5; p. 3:41-50*.

Claims 47 & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable *Adams* in view of *Groetchen*, as applied to claims 1-46, 49-51, & 54-74 above, in further view of Takeuchi et al., U.S. Patent 6,0896,066 (Jul. 11, 2000) (hereinafter "*Takeuchi*").

The gaming system suggested by the combination of *Adams* in view of *Groetchen* describes all the features of the instant claims except sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is revealed. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

*Takeuchi* discloses a game system analogous to *Groetchen* in which movable members are driven by a motor to mask a portion of a game display. *See fig. 1-3*. In particular, the reference describes

sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is set in its desired position. *See col. 5:36-58.*

In view of *Takenchi*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify The gaming system suggested by the combination of *Adams* in view of *Groetchen*, wherein a movable members are driven by a motor to mask a portion of a game display, to add the feature of sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is revealed to provide feedback to the game processor and thereby improve control or detect malfunctions in the operation of the movable member.

Claims 52 & 53 are rejected under 35 U.S.C. 103(a) as being unpatentable *Adams* in view of *Groetchen*, as applied to claims 1-46, 49-51, & 54-74 above, further in view of Heywood et al., U.S. Patent 4,326,351 (Apr. 27, 1982) (hereinafter "*Heywood*").

As stated previously, *Adams* teaches connecting a mechanical secondary display to a processor such that a processor selects symbols for displayed on the secondary display medium. *See col. 3:61-67.* Furthermore, the reference suggests that other known mechanical displays may be substituted for the described wheel display. *See 6:26-34.* Thus, the gaming system suggested by the combination of *Adams* with *Groetchen* describes all the features of the instant claim except a secondary display device having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

*Heywood* discloses a having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display wherein a processor controls the medium to display a selected symbol. *See fig. 2; 1:66-2:20.* The reference teaches that the



roller driven medium provides a better alternative to reels than video displays because players can see the symbols belong to an unalterable strip and avoid an artificial appearance. *See col. 1:38-56.*

Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system described by the combination of *Adams* with *Groetchen* to add the feature of a secondary display device having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display to provides a alternative to a reel display while allowing players can see the symbols belong to an unalterable strip and avoiding an artificial appearance.

In regards to claim 53: The combination of *Adams* with *Groetchen* teaches an actuator causing the movable member to reveal the secondary display after a player activated device is activated. *See id.*

#### ***Terminal Disclaimer***

The terminal disclaimer filed on January 21, 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent No. 6,659,864 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-74 have been considered but are moot in view of the new ground(s) of rejection. Therefore, the previous rejection of claims 1-9, 17-24, 32-35, 43, 57-61, & 72-74 under 35 U.S.C. 102(b) and the previous rejection of claims 11-16, 26-31, 37-42, 44-46, 49-56, & 62-71 under 35 U.S.C. 103(a) are withdrawn.

Applicant's arguments, see pages 1-2, filed January 21, 2005, with respect to double patenting of claims 1-74 of the instant application to claims 1-11 of U.S. Patent No. 6,659,864 have been fully

considered and, due to the filing of a Terminal Disclaimer, are persuasive. The double patenting rejection of claims 1-74 has been withdrawn.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCOTT JONES  
PRIMARY EXAMINER

M.B.S.

A handwritten signature in black ink that reads "Scott Jones". The signature is written in a cursive style with a large, looped "S" and a stylized "J".